

REMARKS

Claims 9-16 were pending in the application. Applicants added claims 17-24 which correspond to originally filed claims 1-8. Hence, claims 9-24 are pending in the application.

Claims 9-16 are rejected under 35 U.S.C. §112, second paragraph. Claims 9-16 are rejected under 35 U.S.C. §103(a). Applicants address these rejections below.

I. REQUEST FOR INFORMATION:

The Examiner requests Applicants to provide references to textbook(s), publication(s), etc., where the equations of claims 13 and 16 can be found. Office Action (12/10/2008), page 2. Applicants' attorney, Bobby Voigt, does not presently have any documentation relating to the limitations of claims 13 and 16. For information regarding these limitations, Applicants kindly direct the Examiner's attention to paragraphs [0021-0024] of Applicants' Specification which discusses the limitations of claims 13 and 16.

II. REJECTIONS UNDER 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner has rejected claims 9-16 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Office Action (12/10/2008), page 3. Applicants amended claims 9 and 13 in a similar fashion as suggested by the Examiner on page 3 of the present Office Action. Accordingly, Applicants respectfully request the Examiner to withdraw the rejections of claims 9-16 under 35 U.S.C. §112, second paragraph.

Claims 9 and 13 were amended as to form and not to overcome prior art. Further, claims 10-12 and 14-16 were amended to be consistent with the amendments to claims 9 and 13, respectively. Hence, no prosecution history estoppel arises from the amendments to claims 9-16. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-12 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 9-16 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises

from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

III. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 9-12 under 35 U.S.C. §103(a) as being unpatentable over Kinra et al. (U.S. Patent No. 5,731,991) (hereinafter "Kinra"). Further, the Examiner has rejected claims 13-16 under 35 U.S.C. §103(a) as being unpatentable over Kinra in view of Wolfram MathWorld (hereinafter "Wolfram"). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections.

A. Claims 9-12 and 17-20 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Kinra.

Applicants respectfully assert that Kinra does not teach "evaluating supplier metrics for customer interest categories to provide numerical values for a software product requirement" as recited in claim 9 and similarly in claim 17. The Examiner cites elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 111 and 122 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4. Applicants respectfully traverse.

Kinra teaches that exemplary criteria includes ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4. Kinra further teaches that each criterion is defined by a group of related product data elements, each product data element comprising an evaluation statement and corresponding numerical value. Column 4, lines 4-7. Additionally, Kinra teaches that for example, a prototype and simulation criterion can be defined by the following evaluation statements and their associated numerical values: (1) supports modeling screen flows and prototyping of character-based interfaces, (2) supports modeling window flows and prototyping of graphic user interface (GUI) based interfaces, (3) supports rapid application development (RAD) techniques, and (4) supports creation

of a performance model. Column 4, lines 7-13. As illustrated in Figure 2 of Kinra, these evaluation statements correspond to elements 126a-126d.

Hence, Kinra teaches using various criteria, such as prototype and simulation criterion, in evaluating a software product. Kinra further teaches that each criterion is defined by a group of related product data elements, each product data element comprising an evaluation statement and corresponding numerical value.

The Examiner equates these criteria (e.g., prototype and simulation criteria) in evaluating a software product as teaching the claimed supplier metrics. The Examiner further equates elements 114a-114c and 126a-126d as teaching the claimed customer interest categories. However, as explained above and illustrated in Figure 2, elements 126a-126d correspond to defining the criterion (e.g., prototyping and simulation criteria 124) by being a group of related product data elements. This group of related product data elements is not a customer interest category. The Examiner has not provided any evidence that these related product data elements are interests from the customers. Instead, if the "criteria" of Kinra are interpreted as being supplier metrics, then the language in Kinra suggests that the group of related product data elements are interests from the suppliers and not from the customers.

Furthermore, elements 114a-114c correspond to criterion that the Examiner asserts teaches the claimed supplier metrics. For example, as illustrated in Figure 2, prototyping and simulation criterion 114c corresponds to prototyping and simulation criteria 124. Hence, elements 114a-114c do not teach customer interest categories using the Examiner's interpretations.

Thus, Kinra does not teach evaluating supplier metrics for customer interest categories to provide numerical values for a software product requirement. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Applicants further assert that Kinra does not teach "computing partial scores for the customer interest categories by weighting and summing the numerical values" as recited in claim 9 and similarly in claim 17. The Examiner cites elements 114a-

114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 111 and 122 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4. Additionally, the Examiner cites elements 118 and 130 as teaching the claimed numerical values. *Id.* Further, the Examiner cites column 4, lines 33-68 of Kinra as teaching the above-cited claim limitation. *Id.* Applicants respectfully traverse.

Kinra teaches that criterion evaluation table 122 corresponds to the prototyping and simulation criterion 114c in category evaluation table 111. Column 8, lines 39-41. Kinra further teaches that a product data column 124 of criterion evaluation table 122 includes a list of product data within the prototyping and simulation criterion, where this product data comprises a plurality of evaluation statements 126a-126d. Column 8, lines 41-44. Further, Kinra teaches that a weighting column 128 of criterion evaluation table 122 contains the criterion weighting values 24 for each product data specified in product data column 124. Column 8, lines 44-47. Additionally, Kinra teaches that a PRODUCT 1 value column 130 and a PRODUCT 2 value column 132 contain the numerical values for PRODUCT 1 and PRODUCT 2, respectively, corresponding to the evaluation statements listed in product data column 124. Column 8, lines 47-51. Additionally, Kinra teaches that a normalized criterion score in the prototyping and simulation criterion is provided at the end of each of the PRODUCT 1 and PRODUCT 2 value columns. Column 8, lines 51-54.

Hence, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion (Examiner asserts that the prototyping and simulation criterion 124 corresponds to the claimed supplier metrics) for products 1 and 2 as illustrated in table 122 of Figure 2. Similarly, Kinra teaches generating normalized criterion scores for the prototyping and simulation criterion for products 1 and 2 as illustrated in table 122 of Figure 2.

Kinra further teaches the process in generating normalized scores, which involves dividing the raw criterion score by the sum of the associated criterion weighting values. Column 4, lines 33-67.

There is no language in Kinra that teaches computing partial scores for the customer interest categories by weighting and summing the numerical values. Instead, Kinra teaches computing normalized scores for the prototyping and simulation criterion which the Examiner asserts teaches the claimed supplier metrics and not the claimed customer interest categories. There is no weighting and summing being performed to obtain the scores associated with elements 126a-126d which the Examiner alleges teaches the claimed customer interest categories.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 9 and 17, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Claims 10-12 and 18-20 each recite combinations of features of independent claims 9 and 17, respectively, and hence claims 10-12 and 18-20 are patentable over Kinra for at least the above-stated reasons that claims 9 and 17, respectively, are patentable over Kinra.

Claims 10-12 and 18-20 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Kinra.

For example, Kinra does not teach "wherein the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability" as recited in claim 10 and similarly in claim 18. The Examiner cites column 4, lines 1-4 and element 112 of Figure 2 of Kinra as teaching the aspects of usability, interoperability and capability. Office Action (12/10/2008), pages 4-5. Applicants respectfully traverse.

Kinra teaches that exemplary criteria include ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4.

The Examiner had previously asserted that elements 112 and 124 correspond to the claimed supplier metrics. Office Action (12/10/2008), page 4. The exemplary criteria cited by the Examiner in column 4, lines 1-4 of Kinra refer to element 124.

Hence, using the Examiner's interpretation of "supplier metrics," the Examiner has not shown that Kinra teaches that customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 10 and 18, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Further, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are old and well known. Office Action (12/10/2008), page 5. While these categories may be known, Applicants respectfully traverse the implied assertion that having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories pursuant to M.P.E.P. §2144.03.

Applicants further assert that Kinra does not teach "wherein the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement" as recited in claim 11 and similarly in claim 19. The Examiner admits that Kinra does not teach the above-cited claim limitation; however, the Examiner asserts that these categories are old and well known. Office Action (12/10/2008), page 5. While these categories may be known, Applicants respectfully traverse the implied assertion that the supplier metrics selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement are evaluated for customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches the

supplier metrics selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement are evaluated for customer interest categories pursuant to M.P.E.P. §2144.03.

Applicants further assert that Kinra does not teach "wherein the step of determining includes a step of averaging non-zero partial scores" as recited in claim 12 and similarly in claim 20. The Examiner cites column 4, lines 40-68 of Kinra as teaching the above-cited claim limitation. Office Action (12/10/2008), page 6. Applicants respectfully traverse.

Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46. Kinra further teaches an example in which two product data elements may be grouped into the automated testing criterion, whereas seven product data elements may be grouped into the process modeling criterion. Column 4, lines 46-49. Kinra further teaches that the two product data elements for the automated testing criterion may have numerical values of "3" and "5", and corresponding criterion weighting values 24 of "5" and "5," respectively. Column 4, lines 49-53. Additionally, Kinra teaches that the raw criterion score for the automated testing criterion is "40" (i.e., $(3 \times 5) + (5 \times 5) = 40$). Column 4, lines 53-54. Further, Kinra teaches that the seven product data elements for the process modeling criterion may have numerical values (1, 3, 3, 0, 5, 1, 3) and corresponding criterion weighting values 24 (5, 1, 1, 3, 5, 3, 3). Column 4, lines 55-58. Furthermore, Kinra teaches that the raw criterion score for the process modeling criterion is "48" (i.e., $(1 \times 5) + (3 \times 1) + (3 \times 1) + (0 \times 3) + (5 \times 5) + (1 \times 3) + (3 \times 3) = 48$). Column 4, lines 58-60. In addition, Kinra teaches that when the raw criterion score of "40" for the automated testing criterion is divided by the sum of the associated criterion weighting values 24 of "10" (i.e., 5 and 5), a normalized score of "4" is generated for this criterion; however, when the raw criterion score of "48" for the process modeling criterion is divided by the sum of its associated criterion weighting values 24 of "21" (i.e., 5, 1, 1, 3, 5, 3, and 3), a normalized score of "2.286" is generated. Column 4, lines 60-67.

Hence, Kinra teaches normalizing a score by dividing the raw score by the sum of the associated criterion weighting values. Normalizing is not the same as averaging the non-zero partial scores. Neither does Kinra teach that the raw score is obtained by taking the average of the non-zero scores. Instead, the raw score is obtained by multiplying the numerical value by its associated weight for each product data element and then summing the weighted numerical values.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 12 and 20, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

- B. Claims 13-16 and 21-24 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Kinra and in further view of Wolfram.

Applicants respectfully assert that Kinra and Wolfram, taken singly or in combination, do not teach "forming an N by M matrix A of numerical values of supplier metrics for customer interest categories of a software product requirement" as recited in claim 13 and similarly in claim 21. The Examiner cites elements 114a-114c and 126a-126d of Kinra as teaching the claimed customer interest categories and further cites elements 111 and 122 of Kinra as teaching the claimed supplier metrics. Office Action (12/10/2008), page 4. Applicants respectfully traverse.

As stated above, Kinra teaches that exemplary criteria includes ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4. Kinra further teaches that each criterion is defined by a group of related product data elements, each product data element comprising an evaluation statement and corresponding numerical value. Column 4, lines 4-7. Additionally, Kinra teaches that for example, a prototype and simulation criterion can be defined by the following evaluation statements and their associated numerical values: (1) supports modeling screen flows and prototyping of character-based interfaces, (2) supports modeling window flows and prototyping of graphic user interface (GUI) based interfaces, (3) supports rapid application development (RAD) techniques, and (4) supports creation

of a performance model. Column 4, lines 7-13. As illustrated in Figure 2 of Kinra, these evaluation statements correspond to elements 126a-126d.

Hence, Kinra teaches using various criteria, such as prototype and simulation criterion, in evaluating a software product. Kinra further teaches that each criterion is defined by a group of related product data elements, each product data element comprising an evaluation statement and corresponding numerical value.

The Examiner equates these criteria (e.g., prototype and simulation criteria) in evaluating a software product as teaching the claimed supplier metrics. The Examiner further equates elements 114a-114c and 126a-126d as teaching the claimed customer interest categories. However, as explained above and illustrated in Figure 2, elements 126a-126d correspond to defining the criterion (e.g., prototyping and simulation criteria 124) by being a group of related product data elements. This group of related product data elements is not a customer interest category. The Examiner has not provided any evidence that these related product data elements are interests from the customers. Instead, if the "criteria" of Kinra are interpreted as being supplier metrics, then the language in Kinra suggests that the group of related product data elements are interests from the suppliers and not from the customers.

Furthermore, elements 114a-114c correspond to criterion that the Examiner asserts teaches the claimed supplier metrics. For example, as illustrated in Figure 2, prototyping and simulation criterion 114c corresponds to prototyping and simulation criteria 124. Hence, elements 114a-114c do not teach customer interest categories using the Examiner's interpretations.

Thus, Kinra does not teach evaluating supplier metrics for customer interest categories of a software product requirement. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 13 and 21, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Claims 14-16 and 22-24 each recite combinations of features of independent claims 13 and 21, respectively, and hence claims 14-16 and 22-24 are patentable over

Kinra in view of Wolfram for at least the above-stated reasons that claims 13 and 21, respectively, are patentable over Kinra in view of Wolfram.

Claims 14-16 and 22-24 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Kinra in view of Wolfram.

For example, Kinra and Wolfram, taken singly or in combination, do not teach "wherein the customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability" as recited in claim 14 and similarly in claim 22. The Examiner cites column 4, lines 1-4 and element 112 of Figure 2 of Kinra as teaching the aspects of usability, interoperability and capability. Office Action (12/10/2008), page 8. Applicants respectfully traverse.

As stated above, Kinra teaches that exemplary criteria include ease of use, application interoperability, automated testing, application partitioning, process modeling, prototyping and simulation, and multilingual support. Column 4, lines 1-4.

The Examiner had previously asserted that elements 112 and 124 correspond to the claimed supplier metrics. Office Action (12/10/2008), page 4. The exemplary criteria cited by the Examiner in column 4, lines 1-4 of Kinra refer to element 124. Hence, using the Examiner's interpretation of "supplier metrics," the Examiner has not shown that Kinra teaches that customer interest categories are selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 14 and 22, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

Further, the Examiner asserts that the categories of performance, reliability, maintainability, documentation, and serviceability are old and well known. Office Action (12/10/2008), page 8. While these categories may be known, Applicants respectfully traverse the implied assertion that having the customer interest categories

selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches having the customer interest categories selected from the set consisting of capability, usability, performance, reliability, interoperability, maintainability, documentation, and serviceability, where supplier metrics are evaluated for these customer interest categories pursuant to M.P.E.P. §2144.03.

Applicants further assert that Kinra and Wolfram, taken singly or in combination, do not teach "wherein the supplier metrics are selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement" as recited in claim 15 and similarly in claim 23. The Examiner admits that Kinra does not teach the above-cited claim limitation; however, the Examiner asserts that these categories are old and well known. Office Action (12/10/2008), page 9. While these categories may be known, Applicants respectfully traverse the implied assertion that the supplier metrics selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement are evaluated for customer interest categories is well known in the art. Applicants kindly request the Examiner to provide a reference that teaches the supplier metrics selected from the set consisting of market penetration, priority as determined by a customer, revenue potential, and state of technology advancement are evaluated for customer interest categories pursuant to M.P.E.P. §2144.03.

Applicants further assert that Kinra and Wolfram, taken singly or in combination, do not teach "wherein the step of determining includes a step of averaging non-zero diagonal elements of P" as recited in claim 16 and similarly in claim 24. The Examiner cites column 4, lines 40-68 of Kinra as teaching the above-cited claim limitation. Office Action (12/10/2008), page 9. Applicants respectfully traverse.

As stated above, Kinra teaches that the criterion score is normalized in the sense that the numerical value of a normalized criterion score does not depend upon the number of product data elements grouped in the corresponding criterion. Column 4, lines 43-46. Kinra further teaches an example in which two product data elements may be grouped into the automated testing criterion, whereas seven product data elements may be grouped into the process modeling criterion. Column 4, lines 46-49. Kinra further teaches that the two product data elements for the automated testing criterion may have numerical values of "3" and "5", and corresponding criterion weighting values 24 of "5" and "5," respectively. Column 4, lines 49-53. Additionally, Kinra teaches that the raw criterion score for the automated testing criterion is "40" (i.e., $(3 \times 5) + (5 \times 5) = 40$). Column 4, lines 53-54. Further, Kinra teaches that the seven product data elements for the process modeling criterion may have numerical values (1, 3, 3, 0, 5, 1, 3) and corresponding criterion weighting values 24 (5, 1, 1, 3, 5, 3, 3). Column 4, lines 55-58. Furthermore, Kinra teaches that the raw criterion score for the process modeling criterion is "48" (i.e., $(1 \times 5) + (3 \times 1) + (3 \times 1) + (0 \times 3) + (5 \times 5) + (1 \times 3) + (3 \times 3) = 48$). Column 4, lines 58-60. In addition, Kinra teaches that when the raw criterion score of "40" for the automated testing criterion is divided by the sum of the associated criterion weighting values 24 of "10" (i.e., 5 and 5), a normalized score of "4" is generated for this criterion; however, when the raw criterion score of "48" for the process modeling criterion is divided by the sum of its associated criterion weighting values 24 of "21" (i.e., 5, 1, 1, 3, 5, 3, and 3), a normalized score of "2.286" is generated. Column 4, lines 60-67.

Hence, Kinra teaches normalizing a score by dividing the raw score by the sum of the associated criterion weighting values. Normalizing is not the same as averaging the non-zero diagonal elements of P. Neither does Kinra teach that the raw score is obtained by taking the average of the non-zero scores. Instead, the raw score is obtained by multiplying the numerical value by its associated weight for each product data element and then summing the weighted numerical values.

Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 16 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. M.P.E.P. §2143.

IV. CONCLUSION:

As a result of the foregoing, it is asserted by Applicants that claims 9-24 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159

P.O. Box 50784
Dallas, TX 75201
(512) 370-2832

Austin_1 558871v.1